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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,226	04/18/2001	Kevin John Moore	169.2025	6435
5514	7590	08/23/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO			WOODS, ERIC V	
30 ROCKEFELLER PLAZA			ART UNIT	
NEW YORK, NY 10112			PAPER NUMBER	
			2672	
DATE MAILED: 08/23/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b></p>	<b>Application No.</b> 09/836,226	<b>Applicant(s)</b> MOORE, KEVIN JOHN	
	<b>Examiner</b> Eric V. Woods	<b>Art Unit</b> 2672	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 08 July 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: \_\_\_\_\_.  
 Claim(s) objected to: \_\_\_\_\_.  
 Claim(s) rejected: \_\_\_\_\_.  
 Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See the note above under Item 3.  
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
 13. ☐ Other: \_\_\_\_\_.

  
 JEFFERY BRIER  
 PRIMARY EXAMINER

Continuation of 3. NOTE: Applicant's arguments with respect to the term 'Directed Acyclic Graph' replacing the term 'Directing Adjacency Graph' and per the abbreviation DAG is a reasonable one (see page 1 of Remarks). However, the other amendments raise new issues and require further search, as will be explained below. Specifically, finally rejected claim 4 concerned certain limitations about traversing the determined portion of a DAG. However, the amendments to claim 1 did far more than merely incorporate that limitation into the independent claim.

Firstly, the preamble is now so large as to have patentable weight, as it does more than simply set forth an intended use. The addition of the limitation 'having object edges' changes the scope of a claim. While from a taxonomic point of view a DAG consists of a set of nodes N with a set of edges E, that was inherently part of the claim without the recitation of that limitation. The specific recitation, as added, requires that each graphic object in a leaf node have object edges, where instead of the edges being a set per se, each node is now required to have ownership per se of one or more edge(s), where before the connections might stand on their own.

Further, in the first method step, the 'groups are bounded by the object edges': This is a new limitation. Previously, examiner had been construing the groups to have the normal meaning associated with the term in graph theory, namely that a set was merely defined by its membership, e.g. a subset of nodes  $N_s = \{1, 2, 3\}$  would be completed defined by reciting its members. However, this limitation imposes additional restrictions on the structure of the graph that requires further search. Therefore, the scope of the independent claims have changed. Also, the addition of the execution limitation changes the scope of the claim and raises new issues. Claim 7 does not fix the deficiencies that are attempted to be corrected in claim 1 and is merely directed to a method of traversing a data structure that is admittedly not novel and is obvious (see pages 1-3 of Remarks, previous, and examiner's previous rejections, supra), e.g. a DAG. That data structure is not new or novel (Warmerdam) and does not cause a computer to operate more efficiently (Lowry). Therefore, it is still non-statutory, and adds further limitations concerned with traversing the tree that were not present in the canceled claim, and the amendment did more than simply bring the limitations of the canceled dependent claim into the body of the relevant independent claim. The other independent claims have similar flaws.

From the perspective of appeal, the applicant proceeds to contest the rejections of claims 1-22 as non-statutory subject matter under 35 U.S.C. 101. Examiner will explain why this rejection is proper. Firstly, applicant admits explicitly on page 2 that such method claims are not limited to execution on or by a computer. The court in *In re Prater* sustained the rejection under 35 U.S.C. 112 of claim 9 on similar grounds (e.g. the claim having broader scope than applicant intended) and \*that\* portion of the logic is applicable. Applicant is put on notice that examiner will include new grounds of rejection in the examiner's answer to reject claims 1-22 under 35 U.S.C. 112 (or else the Board will order a remand to add such rejections) in order that a rejection under 35 U.S.C. 112-35 U.S.C. 101 coupled can be made as per *In re Prater*. Applicant will be permitted to add new arguments to the Appeal Brief directed \*ONLY\* to those new rejections, since applicant has already been amply apprised that such rejections will be added.

Further, under the standard tests applied under 35 U.S.C. 101, applicant admits that the method is generally intended to be carried out on or by a computer. The method as such appears to be directed to a computer program per se, as the process does not recite any pre- or post-computer activity. Further, even with the amendments, there is no intended use recitation. The claims are merely representative of, and embodied by, a method of a traversing a data structure (a Directed Acyclic Graph), and generating instructions. Nothing is done with the instructions and there are no concrete, tangible, or practical applications of the results. Further, the claims do not recite a useful data structure, as in Warmerdam, nor do they cause a computer to operate in a substantially more efficient manner, as per *In re Lowry*. Further, they do not generate billing data or a result (e.g. *AT&T v. Excel Communications*), or provide a purpose or process methodology for generating a tangible result (e.g. *State St.*). They further fail the older Freeman-Walker-Abele test. They do not have any safe harbors.

In short, the revisions raise new issues, change the scope of the claims, require new search, and do not in any case correct all the deficiencies that the examiner rejected the claims on. Further, since entry of the amendment is improper, the arguments directed to why the claims overcome the prior art are moot and therefore are not considered further.